

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 10/065,854 : Confirmation No.: 3376
Applicant: Renuka Uppaluri : Group Art Unit: 2624
Filed: November 26, 2002 : Examiner: Edwards, Patrick L
Docket No.: 122432 CIP/GEM-0018-P :

For: COMPUTER AIDED DIAGNOSIS OF AN IMAGE SET

March 1, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Action dated November 1, 2006, and the Advisory Action dated January 29, 2007, Applicant hereby requests review of the Final Rejection in the above-identified application. No amendments are being filed with this request. This request is being filed concurrently with a Notice of Appeal. This review is requested for the reason(s) stated on the attached sheet(s), which do not exceed more than five (5) pages.

A request for an extension of time under 37 CFR 1.136(a) is provided herewith.

Reasons begin on page 2.

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope, addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at the United States Patent and Trademark Office, on the date shown below.

MaryAnn Stratton
Name

MaryAnn Stratton
Signature

3/1/07
Date

REASONS

Regarding Claim 1 and Rejections under 35 U.S.C. §112, second paragraph:

The claim limitations at issue are directed to:

“...employing a feature selection algorithm on *the region of interest* to sort through candidate features of the region of interest, classifying *a candidate region of interest* on each image, and subsequently combining results of all of the computer aided processing operations...” (Independent Claim 1) (emphasis added).

Dependent claims inherit all of the limitations of the respective parent claim.

The Examiner alleges that Claim 1 is indefinite for reasons stated on pages 2-3 of Final Action Paper No. 20061030.

Applicant respectfully disagrees that Claim 1 is indefinite for reasons stated on pages 10-13 of Amendment Paper dated January 3, 2007.

In alleging indefiniteness, the Examiner “implies” from a reading of the claim that “the region of interest has already been selected and that we are now looking for features within that region of interest. In other words, we would say that *the region of interest* has already been *classified*.” The Examiner then states, “the examiner will interpret the claim such that *the region of interest* has already been *classified* as a region of interest by the time we begin to sort through candidate features on that region of interest.” Paper No. 20061030, page 3.

Here, it appears that the Examiner is equating “*a region of interest*” with “*a candidate region of interest*”, since the Examiner alleges that *the region of interest* is *being classified*. However, Applicant explained, with a great deal of specificity, the error in this correlation, as “*a region of interest*” is *one element of the claim*, and “*a candidate region of interest*” is *another element of the claim*, and that it is *the candidate region of interest* that is being *classified*, not *the region of interest*. Amendment Paper dated January 3, 2007, page 11.

On pages 11-12 of Amendment Paper dated January 3, 2007, Applicant further pointed out how the prosecution history clearly reflects that “*a candidate region of*

interest” is an element of the claim that is different from the element of “a region of interest”.

Here, Applicant submits that by equating one element with another different element, the Examiner has demonstrated clear error based upon a factual deficiency, as the facts are clear from the prosecution history that the two elements are distinctly different. Also, Applicant submits that by failing to consider each and every element of the claimed invention, the Examiner has demonstrated clear error based upon a legal deficiency, as each and every element must be considered when examining the claims.

The Examiner rejects Claims 2-4, 6-19, 21, 22 and 58-61 for indefiniteness based solely on their dependency on Claim 1. Paper 20061030, page 3.

The Examiner also objects to Claims 1-4, 6-19, 21, 22 and 58-61 for allegedly “failing to conform to the invention as set forth in the remainder of the specification”, and states that the reasons for this objection are stated with reference to the indefiniteness rejection. Paper 20061030, page 3.

Applicant respectfully disagrees, and provided several examples of where the specification and claims correlate 1:1. Amendment Paper dated January 3, 2007, pages 11-13.

In the Advisory Action Paper dated January 29, 2007, the Examiner states that to adopt Applicant’s claim interpretation would require an improper incorporation of limitations from the specification. Paper No. 20070124, page 2.

Not only does Applicant respectfully disagree with the Examiner on this point, but also, the Examiner has failed to state with any degree of specificity exactly what limitations are being improperly incorporated into the claims from the specification, thereby demonstrating a second incidence of clear error based upon a legal deficiency, as the Examiner must provide clear reasoning for the basis of each rejection. On pages 11-13 of Amendment Paper dated January 3, 2007, Applicant clearly explained the difference between the two limitations (“a region of interest”, and “a candidate region of interest”), which were already entered into the claims from Amendment Paper dated September 15, 2006, and therefore were not improperly incorporated.

In view of the foregoing, Applicant respectfully submits that for an indefiniteness rejection to stand, the Examiner must show where the claims fail to define patentable subject matter with a *reasonable* degree of particularity and distinctiveness, and by failing to meet this burden, the Examiner has clearly improperly rejected the claims by demonstrating clear error based upon a legal or factual deficiency.

Regarding Rejections Under 35 U.S.C. §103:

The pending claims stand rejected in three groups. Paper No. 20061030, pages 4, 8 and 14.

Applicant traverses the rejections to Group-1 for reasons stated on pages 14-16 of Amendment Paper dated January 3, 2007.

Applicant traverses the rejections to Group-2 for reasons stated on page 16 of Amendment Paper dated January 3, 2007.

Applicant traverses the rejections to Group-3 for reasons stated on pages 16-17 of Amendment Paper dated January 3, 2007.

As set forth above, Applicant submits that the Examiner has improperly equated the element of “*a region of interest*” with the separate different element of “*a candidate reason of interest*”, and as a consequence has failed to show where the references applied against the subject claims teach or suggest *each and every element (both of the above noted elements)* of the claimed invention arranged so as to perform as the claimed invention performs.

In the Advisory Action Paper dated January 29, 2007, the Examiner states that to adopt Applicant’s claim interpretation would require an improper incorporation of limitations from the specification. Paper No. 20070124, page 2.

Applicant respectfully disagrees with the Examiner for reasons already stated above.

For all the reasons stated on pages 14-17 of Amendment Paper dated January 3, 2007, Applicant submits that the Examiner has failed to show where the references teach or suggest each and every element of the claimed invention arranged so as to perform as

the claimed invention performs, and therefore has failed to establish a prima facie case of obviousness.

Accordingly, Applicant submits that the Examiner has clearly improperly rejected the claims by demonstrating clear error based upon a legal or factual deficiency.

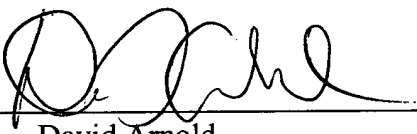
In light of all the forgoing, as well as remarks made in prior responses, Applicant respectfully submits that the Examiner has improperly rejected the claims by demonstrating clear error based upon a legal or factual deficiency. Accordingly, withdrawal of all rejections and notice of allowance of the claims is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that may be required for this submission, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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